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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,358	10/07/2003	Frank J. Schwab	MSDI-245/PC819.00	5654
52196 7590 08/29/2008 KRIEG DEVAULT LLP ONE INDIANA SQUARE, SUITE 2800 INDIANAPOLIS, IN 46204-2709				
EXAMINER				
WOODALL, NICHOLAS W				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
08/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/680,358

Applicant(s)

SCHWAB ET AL.

Examiner

Nicholas Woodall

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-19,22-27,29-40,49-51 and 53-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,11-14,16-19,22,23,26,27,29,30,32,37-40 and 49-51 is/are rejected.
- 7) ☒ Claim(s) 5-8,10,15,24,25,31,33-36 and 53-57 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on 04/22/2008.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips (U.S. Patent 4,677,798).

Phillips discloses a device, for example Figure 5 of the reference, comprising a proximal portion and a distal portion. The proximal portion comprises a frame (44). The distal portion includes a first guide member (a) and a second guide member (b) extending distally from the frame. Each of the first and second guide members include opposite first and second sides extending between a proximal end and a distal end, a planar guide surface extending from the proximal end to the distal end between the first and second sides, and a guide flange extending along only one of the first and second sides projecting from the guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of the first and second guide members, wherein the guide surfaces of the first and second guide members oriented

toward one another when the first and second guide members are mounted on the frame and the guide flanges are opposite each other along a length of the first and second guide members.

4. Claims 38, 39, and 49-51 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent (DE 297 03 850 U1).

The German Patent discloses a device comprising a distal portion and a proximal portion. The distal portion includes a first guide member (first element 9) and a second guide member (second element 9) extending along the first guide member, wherein each of the first and second guide members include a guide surface oriented toward the guide surface of the other of the first and second guide surfaces being generally parallel with one another. The proximal portion includes a frame coupled to the first and second guide members, wherein the frame moves the first and second guide members toward and away from one another with the guide surfaces remaining generally parallel. The frame is transversely oriented to the guide members adjacent the proximal ends of the guide members and oriented at the proximal ends of the guide members such that the guide members are unobstructed between the guide surfaces at the proximal ends to define a proximal opening capable of receiving an implant through the opening for positioning between the guide surfaces of the guide members. The frame includes a stationary arm (6) coupled to one of the first and second guide members and a moveable arm (3) coupled to the other of the first and second guide members, wherein the moveable arm further being movably coupled to the stationary arm. The first and second guide members include opposite first and second sides extending between the

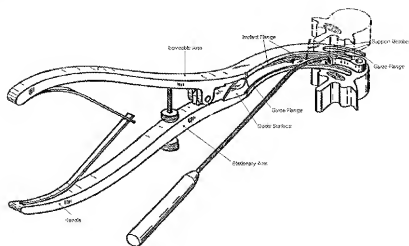
proximal end and the distal end of the guide members, a guide surface extending from the proximal end to the distal end between the first and second sides and being oriented toward the other of the first and second guide member, and a width between the first and second sides greater than a width of an implant to be positioned along the guide surfaces.

5. Claims 1, 9, 11-14, 16-19, 26, 29, 30, 32, 37-40, and 49-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Fuss (U.S. Patent 6,599,294).

Fuss discloses a device comprising a proximal portion and a distal portion (see Figure 1 below). The proximal portion includes a frame, wherein the frame includes a stationary arm with a handle and a moveable arm defining a C-shaped opening between the arms, wherein each of the guide members of the distal portion are transversely connected to the arms of the frame. The guide members include a planar guide surface facing the other of the guide members, a support member, and a guide flange extending along only one side of the guide surface and projecting from the guide surface towards the other guide surface such that the guide flanges are oriented opposite each other along a length of the guide members when the guide members are mounted to the frame, wherein the arms of the frame move the guide members such that the guide surfaces remain parallel.

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Figure 1



Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent (DE 297 03 850 U1) in view of Zinkel (U.S. Publication 2004/0024291).

The German Patent discloses the invention as claimed except for the guide members being connected to the arms of the frame by a dovetail connection. The German Patent discloses a device wherein the guide members are connected to the arms of the frame by a pin and slot connection in order to removably connect the guide members to the arms of the frame. Zinkel teaches a device comprising first and second guide members connected to the arms of a frame by a dovetail connection in order to

removably connect the guide members to the arms of the frame. Because both the German Patent and Zinkel teach devices comprising guide members connected to arms of a frame by a connection, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute one connection for another in order to removably connect the guide members to the arms of the frame.

8. Claims 3, 4, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss (U.S. Patent 6,599,294) in view of Moskovich (U.S. 5,431,658).

Fuss discloses the invention as claimed except for the guide members further comprising an abutment member adjacent the distal end of the guide member, wherein the abutment member projects in a direction opposite the guide surface. Moskovich teaches a device comprising guide members including guide surface and a support member, wherein an abutment member protrudes from the guide member proximal the support member in a direction opposite the guide surface in order to limit the insertion of the guide members into an intervertebral disc space. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Fuss further including an abutment member proximal the support member in view of Moskovich in order to limit the insertion of the guide members into an intervertebral disc space.

Allowable Subject Matter

9. Claims 5-8, 10, 15, 24, 25, 31, 33-36, and 53-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 3-19, 22-27, 29-40, 49-51, and 53-57 have been considered but are moot in view of the new ground(s) of rejection. The examiner has provided new grounds of rejection as necessitated by the amendment making this office action **FINAL**.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is (571)272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas Woodall/
Examiner, Art Unit 3733
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733